



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,037	12/10/1999	MASASHI HAMADA	1232-4604	9614

7590 03/03/2003
MORGAN & FINNEGAN LLP
345 PARK AVE
NEW YORK, NY 10154

EXAMINER

DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/459,037

Applicant(s)
Hamada et al.

Examiner
Temica M. Davis

Art Unit
2685



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 22, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 12, 15, 16, 19-28, 31-33, and 35-56 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 12, 15, 16, 19-28, 31-33, and 35-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

Art Unit: 2685

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1 and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Tiedemann, Jr. et al (Tiedemann), U.S. Patent No. 5,862,471.

Regarding claims 1, 20 and 21, Tiedemann discloses transmitting a registration request to a communication network; performing communication for an authentication process with the communication network after the transmission of the registration request (col. 2, lines 9-14) and outputting a communication charge in accordance with data relating to a communication line , wherein the data relating to the communication line is received from the communication network after the authentication process (col. 2, lines 19-21).

Regarding claim 19, Tiedemann discloses wherein said receiving means receives the data in an outgoing-call sequence without specifying a connecting network for connecting the communication network and another network to which a communicating party is to be connected (col. 3, lines 22-43).

Art Unit: 2685

Regarding claims 22-24, Tiedemann discloses receiving data on a communication line in accordance with a roaming sequence with a communication network (col. 3, lines 22-43) and outputting a communication charge in accordance with the data received (col. 3, lines 22-45).

3. Claims 25-27, 47, 49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Reece et al (Reece), U.S. Patent No. 5,915,214.

Regarding claims 25-27, Reece discloses receiving data from a communication network (col. 6, lines 21-34); outputting a communication charge in accordance with data received from the communication network in a registration sequence (col. 12, lines 63-66); and outputting time (call duration; figure 7) in accordance with the data received from the communication network (col. 15, lines 4-9).

Regarding claims 47, 49 and 51, Reece discloses receiving data from a communication network (col. 6, lines 21-34); outputting time in accordance with the data received from the communication network in a registration sequence (col. 15, lines 4-9).

4. Claims 33, 45, 53 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Steijer, U.S. Patent No. 6,408,174.

Regarding claim 33, Steijer discloses connecting a radio terminal via a radio channel and notifying the radio terminal in a registration sequence of charge data relating to a communication

Art Unit: 2685

charge, and notifying the radio terminal of time data relating to the radio network (col. 3, lines 48-67).

Regarding claim 45, Steijer discloses executing a registration sequence between a radio network and a radio terminal (col. 3, lines 49-54), transferring charge data relating to a communication charge from the radio network to the radio terminal in the registration sequence (col. 3, lines 54-64); and transferring time data relating to the radio network to the radio terminal (col. 3, lines 54-64).

Regarding claim 53, Steijer discloses connecting a radio terminal via a radio channel (col. 3, lines 49-54), and notifying the radio terminal in a registration sequence of time data relating to the radio network (col. 3, lines 54-64).

5. Claim 36 is rejected under 35 U.S.C. 102(e) as being anticipated by Granberg, U.S. Patent No. 6,195,543.

Regarding claim 36, Granberg discloses a method for enabling a network to calculate a communication charge, comprising the steps of: executing an outgoing-call sequence between a radio network and a radio terminal (col. 5, lines 38-47); and transferring data on a communication line from the radio network to the radio terminal for enabling the radio terminal to calculate the communication charge in a case where the outgoing-call sequence is executed without specifying a connecting network (as evidenced by the fact that the AoC parameters

Art Unit: 2685

transmitted are related to the serving cell; col. 5, lines 60-65) which connects the radio network and another network connecting a communicating party (col. 5, line 65-col. 6, line 23).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7, is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann in view of Steijer.

Regarding claim 7, Tiedemann discloses the apparatus of claim 1 as described above. Tiedemann, however, fails to disclose receiving time data relating to the communication line.

In a similar field of endeavor, Steijer discloses a communication device that outputs charges in accordance with received data from a communication network. Steijer further discloses receiving time data from the network relating to a communication line (col. 3, lines 54-61).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Tiedemann with the teachings of Steijer for the purpose of ensuring a user of a radio terminal of time relating to the network in order to obtain accurate charges for a call.

Art Unit: 2685

8. Claims 12, 15, 16, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann.

Regarding claims 12, Tiedemann discloses the method/apparatus according to claim 1 as described above.

Tiedemann, however, fails to specifically disclose receiving country data relating to a communication line.

The examiner, however, contends that such a technique is very well known in the art, and the examiner takes official notice as such.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Tiedemann with the teachings of well known prior art for the purpose of allowing the user to make a better estimation of how much roaming charges should be.

Regarding claims 15 and 16, Tiedemann discloses the apparatus of claim 1 as described above.

Tiedemann, however, fails to disclose output means for outputting a communication history that includes information indicating locations where calls are made and indications of collect calls.

The examiner, however, contends that such a technique is very well known in the art, and the examiner takes official notice as such.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Tiedemann with the teachings of well known prior art for the purpose of allowing a

Art Unit: 2685

user of the radio terminal to keep track of communications in order to be sure that appropriate charges have been applied to all calls.

Regarding claims 38 and 40, Tiedemann discloses the method/apparatus of claims 20 and 21 as described above.

Tiedemann, however, fails to specifically disclose outputting country data relating to a communication line.

The examiner, however, contends that such a technique is very well known in the art, and the examiner takes official notice as such.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Tiedemann with the teachings of well known prior art for the purpose of allowing the user to see where the user has roamed in order to make a better estimation of how much roaming charges should be.

9. Claims 44, 46, 54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steijer in view of Tiedemann.

Regarding claims 44, 46, 54 and 56, the combination of Steijer discloses the apparatus/method according to claims 33, 45, 53 and 55 as described above.

Steijer, however, fails to disclose an authentication process before transferring charge and time data.

Art Unit: 2685

Tiedemann reads on this limitation. Tiedemann discloses a system that authorizes a communication terminal prior to transmitting information relating to communication charges to the terminal.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Steijer with the teachings of Tiedemann for the purpose of decreasing illegal use of a radio terminal in the communication system.

10. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reece in view of Granberg.

Regarding claim 31, Reece discloses connecting a radio terminal via a radio channel (col. 10, lines 40-50); and inherently notifying the radio terminal in a registration sequence of data on a communication line (since the mobile displays such information (figure 7)) for enabling the radio terminal to output a communication charge (col. 12, lines 63-66).

Reece, however, fails to disclose wherein the radio terminal is able to calculate a communication charge.

In a similar field of endeavor, Granberg discloses a system which transmits information relating to the cost of a call to a radio terminal. Granberg further discloses wherein the radio terminal is able to calculate a communication charge.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Reece with the teachings of Granberg for the purpose of reducing the burden of the

Art Unit: 2685

communications network from having to perform its other functions such as routing, switching, etc., in addition to having to calculate airtime charges.

Regarding claim 32, Reece discloses executing a registration sequence between a radio network and a radio terminal (col. 11, line 57-col. 12, line 5); and transferring data on a communication line in the registration sequence from the radio network to the radio terminal for enabling the radio terminal to output a communication charge (12, lines 63-66).

Reece, however, fails to disclose wherein the radio terminal is able to calculate a communication charge.

In a similar field of endeavor, Granberg discloses a system which transmits information relating to the cost of a call to a radio terminal. Granberg further discloses wherein the radio terminal is able to calculate a communication charge.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Reece with the teachings of Granberg for the purpose of reducing the burden of the communications network from having to perform its other functions such as routing, switching, etc., in addition to having to calculate airtime charges.

11. Claims 28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granberg.

Regarding claim 28, Granberg discloses sending an outgoing call signal (originating call signal) to a communication network (col. 5, lines 42-47), sending data relating to a

Art Unit: 2685

communication line (AoC parameters) of the serving cell (col. 5, lines 62-65), receiving the data relating to the communication line transmitted from the network (col. 5, line 66-col. 6, line 2), and outputting a communication charge in accordance with the data on the communication line received (col. 5, line 66-col. 6, line 2).

Granberg, however, fails to disclose wherein a request signal includes a specified connecting network that is judged by the network before transmitting the communication line information.

The examiner contends, however, that request signals are very well known in the art, and the examiner takes official as such.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Granberg with the teachings of well known prior art in instances where a user may not want automatic receipt of call charge information.

Further, although Granberg sends AoC data relating to a serving cell and not a specified cell, such a limitation would have been obvious to a person of ordinary skill in the art at the time of invention to allow more user intervention in deciding which network he/she may want to receive information on prior to connecting a communication with a network.

Regarding claim 35, Granberg discloses connecting a radio terminal via a radio channel (col. 5, lines 38-47); and notification means for notifying the radio terminal of data on a communication line for enabling the radio terminal to calculate a communication charge (col. 5, line 65-col. 6, line 23).

Art Unit: 2685

Granberg, however, fails to disclose wherein a connecting network which connects the radio network and another network connecting a communicating party has been specified, rather, shows gives AoC parameters to the serving and surrounding cell.

The examiner contends, however, that at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Granberg by giving a specific connecting network, rather than the serving cell as mentioned above, to allow more user intervention in deciding which network he/she may want to receive information on prior to connecting a communication with a network.

12. Claims 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann in view of Reece.

Regarding claims 37 and 39, Tiedemann discloses the methods as described in claims 20 and 21 above.

Tiedemann, however fails to disclose time data relating to a communication line is outputted.

In a similar field of endeavor Reece discloses a system for outputting information relating to communication charges. Reece further discloses outputting time data relating to a communication line (col. 15, lines 4-9).

Art Unit: 2685

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Tiedemann with the teachings of Reece for the purpose of keeping track of the minutes used in a telephone conversation to help a user not exceed preset cost limits.

13. Claims 41-43, 48, 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reece in view of Tiedemann.

Regarding claims 41-43, 48, 50 and 52 Reece discloses the apparatus/method of claims 25, 26, 27, 47, 49 and 51 as described above.

Reece, however, fails to disclose an authentication process before outputting charge and time data.

Tiedemann reads on this limitation. Tiedemann discloses a system that authorizes a communication terminal prior to transmitting information (for output at the radio terminal) relating to communication charges to the terminal.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Reece with the teachings of Tiedemann for the purpose of decreasing illegal use of a radio terminal in the communication system.

Art Unit: 2685

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Edward Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 Customer Service whose telephone number is (703)306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for any communications intended for entry).

*Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).*

Temica M. Davis
February 24, 2003


TEMICA M. DAVIS
PATENT EXAMINER